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In re Application of TAKAI et al. :
Application No.: 10/590,872 :
PCT No.: PCT/JP05/03018 :
Int. Filing Date: 24 February 2005 : DECISION ON PETITION
Priority Date: 27 February 2004 :
Attorney Docket No.: 5048/76775 :
For: OPTICAL MEMBER AND BACKLIGHT :
USING THE SAME

This decision is issued in response to applicants' "Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment" dated 30 July 2008. Additionally, this decision is issued in response to applicants' 02 July 2007 submission of a declaration, treated herein as a petition under 37 CFR 1.182 to correct the name of second inventor. Deposit Account No. 03-3125 will be charged the required petition fee.

BACKGROUND

On 24 February 2005, applicants filed international application PCT/JP05/03018. The international application claimed a priority date of 27 February 2004, and it designated the United States. On 09 August 2005, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB"). The deadline for payment of the basic national fee was thirty months from the priority date, i.e., 27 August 2006.

On 25 August 2006, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee; an executed declaration; and a translation of the international application into English.

On 30 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration was defective because the second inventor was not identified by the name listed on the international application. The notification set a TWO (2) MONTH period for response.

On 07 July 2008, mailed a Notification of Abandonment indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 30 April 2007 within the time period set therein.

On 30 July 2008, applicants filed "Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment" which included a declaration considered herein. The declaration identified the second inventor as "Sachiko Ando nee Sachiko Araki." The name of record for this inventor, as set forth on the published international application, is Sachiko Araki.

DISCUSSION

A. Response to Notification of Missing Requirements

Applicants state in the present petition that there was a typographical error on the Response to Notification of Missing Requirements under 35 U.S.C. 371 filed on 02 July 2007. More specifically, the serial number on the cover page was incorrectly indicated as '10/590,871.' Due to applicants' typographical error, the papers were placed in 10/590,871. The papers have been removed from application number 10/590,871 and placed in application folder number 10/590,872. Therefore, the Notification of Abandonment mailed 07 July 2008 is hereby VACATED.

B. Petition under 37 CFR 1.182 (Name of Second Inventor)

As stated above, the declaration filed 25 August 2006 (and 02 July 2007) identified the second inventor as Sachiko ANDO. Section 605.04(b) of the Manual Of Patent Examining Procedure ("MPEP") states that:

Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 35 U.S.C. 1.182 together with an appropriate petition fee.

In this case, the surname of the second inventor is listed as "ARAKI" on the published international application and as "ANDO" on the declaration. This is more than a mere typographical error or a phonetic misspelling of the applicant's name. Accordingly, the submission of this declaration has been treated as a petition under 37 CFR 1.182 to correct the name of record for this inventor. For such a petition to be grantable, MPEP § 605.04(c) states that "the petition must include an appropriate petition fee and a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a copy of the court order."

Here, applicants' submission included the authorization to charge Deposit Account No. 03-3125 for required fees. Based on this authorization, the Deposit Account will be charged the requisite petition fee of \$400. However, applicants have not submitted the

required statement from the inventor (or court order) confirming the name change and the procedure whereby the name was changed (for example, by marriage). It is noted that the 02 July 2007 submission of a "Japanese Language Declaration (of inventorship)" executed by the second inventor as "Sachiko Ando nee Sachiko Araki" is not an acceptable statement.

Because applicants have failed to submit all the requirements for a grantable petition, correction of the inventor's name on the present record is inappropriate. Accordingly, the declaration filed 25 August 2006, which identifies the second inventor as Sachiko Ando, is defective for failure to properly identify the inventors of record herein.

CONCLUSION

Applicants' petition under 37 CFR 1.182 is DISMISSED without prejudice. The declaration submitted by applicants on 06 June 2006 is defective for failure to properly identify the inventors of record.

The Notification of Abandonment mailed 07 July 2008 is hereby VACATED.

Any request for reconsideration on the merits must be filed within TWO (2) MONTHS from the mail date of this decision. Any such response must include the statement required for a grantable petition under 37 CFR 1.182 regarding the change of the inventor's name and the procedure whereby the change of name was effected, as discussed above and in the MPEP, as well as complete copies of the declarations executed by the inventors herein. Such submission should also include a corrected application data sheet that lists the correct name for the second inventor.

Failure to file a proper response in a timely manner will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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